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APR 13 2004

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OFFICE OF PETITIONS

In re Application of :
Moss and Howard : DECISION ACCORDING STATUS
Application No. 10/667,021 : UNDER 37 CFR 1.47(a) AND
Filed: 6 February, 2004 : DECISION ON PETITION
Atty Docket No. 03-0172 : UNDER 37 CFR 1.53

This is in response to the petition filed under 37 CFR 1.47(a) on 12 February, 2004. This is also a decision on the petition under 37 CFR 1.53 to accord the above-identified application a filing date of 18 September, 2003, with four (4) sheets of drawings including Figure 4, as a part of the original disclosure.

The petition is **GRANTED**.

Petition Under 37 CFR 1.47(a)

Petitioners have shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been sent a copy of the application papers. Specifically, petitioners have established that a copy of the application was sent to the non-signing inventor, Robert Moss. However, the non-signing inventor orally refused, during a telephone call with petitioner's registered patent attorney, Daniel N. Fishman, to sign and return an executed declaration listing him as a joint inventor along with Michael Howard.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

Petition Under 37 CFR 1.53

The application was filed on 18 September, 2003.

Accordingly, on 12 December, 2003, Initial Patent Examination Division mailed a Notice of Omitted Item(s) in a Nonprovisional Application, stating that the application had been accorded a filing date of 18 September, 2003, but that Figure 4 described in the specification appeared to have been omitted.

In response, on 12 February, 2004, the present petition and a copy of four (4) sheets of drawings containing Figures 1-5 were filed. Petitioners argue that one sheet of drawings containing Figure 4 was filed with the other application papers on 18 September, 2003, but was subsequently misplaced in the U.S. Patent and Trademark Office (Office). In support, a copy of petitioners' postcard receipt was supplied with the present petition. The postcard receipt shows an Office date stamp of 09/18/03, the above-identified application number, and identifies the application by first named inventor's name and invention title, and acknowledges receipt of, *inter alia*, "Figures (4 pages)". Petitioners request that the application, including one sheet of drawings containing Figure 4, be accorded a filing date of 18 September, 2003.

A review of the record reveals that three (3) sheets of drawings containing Figures 1-3 and 5 have been located among the application papers received on 18 September, 2003. However, the evidence is convincing that the application papers deposited on 18 September, 2003, included four (4) sheets of drawings, one of which was subsequently misplaced in the Office. Therefore, the application, including the one (1) sheet of drawings containing Figure 4 described in the specification, is entitled to a filing date of 18 September, 2003.

The "Notice" mailed on 12 December, 2003, is vacated to the extend that it stated that Figure 4 appeared to have been omitted.

In view of the above, the petition is granted. No petition fee is due and none has been charged.

The application will be processed with the copy of one (1) sheet of drawings containing Figure 4 supplied on 12 February, 2004, as a part of the original disclosure. The copies of the other drawing sheets supplied with the present petition will not be

used for processing or examination, but will be retained in the application file.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 18 September, 2003, using the application papers filed on that date, and the copy of one (1) sheet of drawings containing Figure 4 supplied with the present petition.

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions



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OFFICE OF PETITIONS

In re Application of
Moss et al.

Application No. 10/667,021

Filed: 18 September, 2003

For: METHODS AND STRUCTURE FOR SCAN TESTING OF SECURE SYSTEMS

Dear Mr. Moss:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at 703/308-6918. Requests for information regarding your application should be directed to the File Information Unit at 703/308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at 703/308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

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